

### **REMARKS**

Applicants respectfully request reconsideration and allowance in view of the replacement declaration and statement of facts and the following remarks.

#### **Declaration Under 37 CFR 1.131**

The Office Action states that the Declaration filed under 37 CFR 1.131 is ineffective to overcome the Rui's reference dated September 13, 1999. Applicants partially traverse this finding and respectfully submit a replacement declaration under 37 CFR 1.131. Applicants shall present arguments addressing each of the points outlined on page 3 of the Office Action.

First, Applicants' replacement declaration includes the correct serial number, 10/824,663.

Second, Applicants' replacement declaration includes the phrase "we declare" as noted in the Office Action.

Third, the facts in the declaration establish a date of conception of a network-based service to provide on-demand video summaries of television programs at least 13 August 1999, as shown by Exhibit A of the Declaration. The inventors submitted the disclosure to AT&T for patent review on 23 August 1999, still before Rui et al.'s provisional filing date of 13 September 1999. The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. Conception is less a matter of signature than it is one of disclosure. Attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out

expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.). MPEP 2138.06. In this case, Application 09/577,642, the parent of the instant application, was filed on 24 May 2000, nine months after the disclosure was submitted to AT&T. Applicants submit that the time frame of nine months is manifestly diligent given the patent review process of a large corporation such as AT&T, the time to assign the application to an attorney to an attorney, and the requisite time to prepare and file a patent application.

Fourth, Exhibit A does show all the limitations of the claims. As an example, Exhibit A teaches each limitation of independent claim 32. Exhibit A teaches “dividing a received program into program segments” at page 1 which states “‘Video hyperlinks’ allow a customer to efficiently view a segment from a program that is associated with a segment from a summary.” Exhibit A teaches “summarizing and storing each program segment into a corresponding summary segment, wherein each summary segment includes audio, full-motion video, and at least one still picture” at page 1 which states “A summary is an abbreviated version of the program. It may contain audio, snapshots, and full-motion video that have been extracted from a program.” Exhibit A teaches “generating metadata files for delimiting a beginning and an end of summary segments and program segments” at page 1 which states “In both embodiments, broadcasters transmit summaries that include the information required for the features of this invention” and “‘Video hyperlinks’ allow a customer to efficiently view a segment from a program that is associated with a segment from a summary.” The information required for the features can include metadata and the video hyperlink can include a beginning point and an end point of the hyperlinked segments. Lastly, Exhibit A teaches “upon a request from a user from a client device, supplying the summary segments in lieu of program segments, the summary segments being streamed in a first channel to the client device and the program segments being

streamed in a second channel to the client device” at page 1, which states “A customer can use a summary to indicate the segments of a program that he or she wishes to record. One embodiment of this invention for cable access requires enhancements to the set top boxes (STBs) at the customer premises.” The indication of segments of a program and the recording can be transmitted on separate channels.

Fifth, Applicants’ replacement statement of facts includes the phrase “I declare” as noted in the Office Action.

Sixth, the statement of facts is not intended to assist in antedating the disclosed prior art. Upon a careful reading, the statement of facts is directed to showing that we are unable to locate or contact Vijay Bhagavath or Joseph Thomas O’Neil, two of the inventors. Thus the dates of the electronic documents in the statement of facts are unrelated to the issue of establishing a date of conception prior to Rui et al.

Seventh, as explained above, the documents in the statement of facts are not intended to establish reduction to practice.

Having addressed the issues pointed out in the Office Action, Applicants respectfully submit that the replacement declaration and the arguments presented herein place the application in condition for allowance.

### **Double-Patenting Rejections**

The Office Action rejects the claims provisionally on the ground of non-statutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,829,781. The enclosed Terminal Disclaimer addresses the double patenting rejection. Therefore, Applicant respectfully submits that these claims are allowable.

**Rejection of Claims 32-37, 39 and 40-43 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 32-36, 39 and 40-43 under 35 U.S.C. §103(a) as being unpatentable over Sezan et al. (U.S. Patent No. 6,236,395) (“Sezan et al.”) in view of Rui et al. (U.S. Patent Publication No. 2005/0160457) (“Rui et al.”). Applicants traverse this rejection and submit that the Declaration establishes a date of invention prior to the effective 102(e) date of Rui et al. 35 U.S.C. §102(e), allows for U.S. patents and U.S. patent application publications to be applied against the claims as of their effective U.S. filing dates. MPEP 706.02(f). Rui et al. is a divisional of Application No. 09/660,529 filed Sep 13, 2000, now issued as U.S. Patent No. 7,028,325, which claims priority from provisional application 60/153,730 filed Sep 13, 1999, making this Rui et al.’s effective U.S. filing date.

This application is a continuation of application no. 09/577,642, now issued as U.S. Patent No. 6,829,781, filed May 24, 2000. The declaration offers evidence that Applicants conceived of the invention prior to Rui et al.’s filing date of 13 Sep 1999. The first piece of evidence is an internal patent review document dated 13 Aug 1999 which substantially describes the invention. Declaration, Exhibit A. The second piece of evidence is an email dated 23 Aug 1999 from inventor Vijay Bhagavath to Joyce Burns for patent review. Declaration, Exhibit B. These two documents show that Applicants conceived of the invention prior to Rui et al.’s filing date. Further, Applicants conceived the invention prior to Rui et al.’s filing date as evidenced by their submitting the invention for internal AT&T review and preparation of the patent application. The inventors entrusted the preparation and filing of the patent application to AT&T. Exhibits G and H of the declaration of Thomas Isaacson shows that this case was assigned to AGS or Alfred G. Steinmetz on 28 October 1999 to draft the application. Exhibit G at page 2 further shows that Mr. Steinmetz was assigned a total of four cases at roughly the same time as the instant application. 1999-0494 was listed last of the four assigned cases. The

diligence of Mr. Steinmetz in preparing and filing patent application inures to the benefit of the inventor. MPEP 2138.06. Robert Markowitz signed the declaration on 3 April, 2000, as shown in Exhibit I at the top of page 3, indicating that the draft was substantially complete for filing as of that time. The prompt preparation and filing of the application, only 6 months from the time Mr. Steinmetz received the initial disclosure to the declaration, taking in to account the four cases assigned to Mr. Steinmetz at roughly the same time is evidence of attorney diligence.

Accordingly, Applicants submit that the evidence in the declaration establishes a date of conception prior to the filing date of Rui et al. and further submit that Rui et al. is not available as prior art. Applicants therefore respectfully request that the 35 U.S.C. §103(a) rejection be withdrawn.

**Rejection of Claims 50-57 and 59-63 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 50-57 and 59-63 under 35 U.S.C. §103(a) as being anticipated by Rui et al. and further in view of Sezan et al. Applicants traverse this rejection inasmuch as Rui et al. is unavailable as prior art as set forth above. For these reasons, Applicants submit that claims 50-57 and 59-63 are patentable over the cited references. Accordingly, Applicants respectfully request that this rejection be withdrawn.

**Rejection of Claims 38, 44-49 and 58 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 38, 44-49 and 58 under 35 U.S.C. §103(a) as being unpatentable over Sezan et al. and Rui et al. and further in view of Seidman et al. (U.S. Patent No. 6,298,482) ("Seidman et al."). Applicants do not acquiesce that it would have been obvious to one of skill in the art to combine Sezan et al. and Rui et al. with Seidman et al. and reserve the right to argue against their combination.

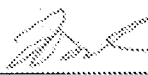
Applicants note that claims 38, 44-49, and 58 depend from and include the limitations of claim 32. However, inasmuch as Rui et al. is not available as prior art, as set forth above, the proposed combination of references does not teach the limitations of claims 38, 44-49, and 58. Accordingly, Applicants respectfully request that the 35 U.S.C. §103(a) rejection be withdrawn.

### CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

Date: November 2, 2009

By:  \_\_\_\_\_

Correspondence Address:

Thomas A. Restaino  
Reg. No. 33,444  
AT&T Corp.  
Room 2A-207  
One AT&T Way  
Bedminster, NJ 07921

Thomas M. Isaacson

Attorney for Applicants  
Reg. No. 44,166  
Phone: 410-286-9405  
Fax No.: 410-510-1433